

or, as an apparent alternative to Schneier and Simmons, in view of Venkatraman (U.S. Patent No. 5,995,487) alone, or, as another apparent alternative to Schneier and Simmons, in view of Goldberg et al (Web article, Goldberg) and Schneier or Simmons.

RESPONSE TO OBJECTION TO FIGURE 1

Turning first to the objection to Figure 1 that is again presented based upon the oversimplification that Figure 1 shows what is old in the art, it is again noted that the description of Figure 1 at page 17, line 15, through page 18, line 9, in the specification makes it clear that this figure represents a schematic view "of a constitution of a preferred embodiment of the invention." As noted in the last response and accompanying petition, this schematic view of the preferred embodiment includes terminals 1-1 and 1-4 that are shown in more detail in Figure 2 and Figure 3, and not simply just providers 3-1 and 3-2 being connected to the internet 4. The inclosed proposed drawing correction letter submitted for approval includes the annotation "(FIG. 2)" to be added below "1-1" and "(FIG. 3)" to be added below "1-4" to clarify that this Figure does not merely illustrate that which is old as improperly alleged.

SUMMARY

Before considering the outstanding prior art rejection, it is noted that the present invention is concerned with methods and apparatus for using an encrypted electronic mail based remote reservation control to control the timer reservation of a video recorder that plays no part in receiving, decrypting or storing only commands from certified users.

RESPONSE TO REJECTIONS

To whatever extent Naughton teaches remote control of electric devices via a graphical user interface, col. 27, lines 1-3 teach nothing other than sending a remote message over a communications network to invoke a driver program. While such a message can be in a packet as noted in col. 28, lines 8- 32, this teaching of packets is not a teaching the artisan would reasonably refer to as “electronic mail.” It is well established precedent that while the PTO is to give claim language its broadest “reasonable” interpretation, this does not mean that the PTO can completely ignore the understanding that the artisan would have of words used in the claims read in light of the specification and the prior art to ascribe a completely different meaning thereto. See In re Cortright 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.”). As further noted in Cortright (id.):

“Prior art references may be “indicative of what all those skilled in the art generally believe a certain term means . . . [and] can often help to demonstrate how a disputed term is used by those skilled in the art.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584, 39 USPQ2d 1573, 1578-79 (Fed. Cir. 1996). Accordingly, the PTO’s interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art. *Cf. Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029 (approving the board’s definition of claim terms consistent with their definitions in CCPA cases). (Emphasis in original.)

The PTO cannot reasonably cite and rely on Schneier (E-Mail Security, How to Keep Your Electronic Messages Private. John Wiley & Sons, 1995) as evidence of prior art electronic mail knowledge while ignoring the statements therein defining these to be user-to-user addressed messages over a decentralized E-mail network as explained in the second full paragraph on the first page of Chapter 1. Whatever else might be said about the graphical interface messages taught by Naughton, it is clear that the artisan familiar with electronic

mail messages as defined by Schneier would not mistake these graphical interface messages for “electronic mail” simply because they are electronic in form and sent over a network as erroneously stated on page 3 of the outstanding Action.

In addition, and as noted in the last response, the PTO reviewing court has recently repeated the well established rule that it is error to attempt to extract abstract isolated teachings from a reference. See In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[reference] statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference.”). The context of Naughton is the use of a hand-held display device for remote control of electric devices via a graphical user interface, not storing control signals retrieved from “electronic mail” as claimed.

As further explained by the court in In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)(“This court forbids the use of hindsight in the selection of references that comprise the case of obviousness. *See In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).”). Further note Rouffet, at 47 USPQ2d 1459:

[T]he [PTO] must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the [PTO] must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. [Emphasis added.]

Clearly, the PTO has a duty of explaining why the artisan would have been led to even consider the Schneier electronic mail text, the Simmons cryptography text, the Venkatraman web server teachings, and/or the Goldberg teachings of a “Mosaic” server web server as sources of teachings to modify the Naughton graphical interface not involved with “electronic mail” transmissions or servers. Instead of presenting any such reasonable bases, the outstanding Action does little more than attempt to establish that some of the component parts of the claimed combinations were individually known.

However, such an approach is clearly wrong as further noted by the court in Rouffet, at 47 USPQ2d 1457:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

As further noted in the last response:

A similar attempt to substitute abstract conclusions as to motivation for a proposed reference modification was recently overturned by the PTO reviewing court in In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) that held that "[w]ith respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete evidence in the record in support of these findings. Also note In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) as follows:

The factual inquiry whether to combine references must be thorough and searching. It must be faced on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

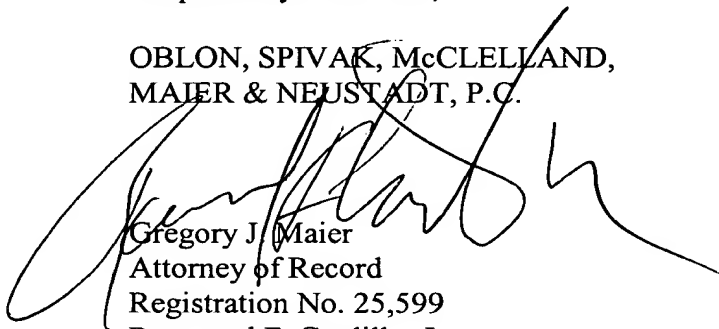
However, dispensing with any "objective evidence" and substituting "subjective belief and unknown authority" as to this question material to patentability is at the very heart of this rejection in clear defiance to Lee at 61 USPQ2d 1434 and at 61 USPQ2d 1435 which notes that the PTO is required to follow binding precedent ([s]ound administrative procedure requires that the agency apply the law in accordance with statute and precedent.) .

Turning to the subject matter of dependent Claims 3 and 4, it is first noted that these claims are respectively dependent on Claim 1 and should be considered allowable for the same reasons that Claim 1 is. In addition, each of these dependent claims add further features that have been improperly interpreted and treated in the outstanding rejection.

As no further issues are believed to be outstanding in the present application, it is believed that the present application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Raymond F. Cardillo, Jr.
Registration No. 40,440



22850

(703) 413-3000
Fax No.: (703) 413-2220
GJM/RFC/kst

I:\atty\rfc\203577-am3.wpd

Marked-Up Copy

Serial No: 09/059,765

Amend. Filed on: 12/13/02

IN THE CLAIMS

--1. (Four Times Amended) A reception device for controlling [an electric appliance] a video recording device physically separate from to the reception device, the reception device comprising:

reception means for receiving an electronic mail transmitted through a network;

first extracting means for extracting encrypted certification information inserted in said electronic mail received by said reception means;

second extracting means for extracting a control command inserted in said electronic mail received by said reception means for controlling a remote timer video recording reservation function of [an external] the physically separate video recording device, wherein said control command is added to said electronic mail to [control said electric appliance] reserve an operation time of said physically separate video recording device;

decrypting means for decrypting said certification information extracted by said first extracting means;

certifying means for certifying, by referencing the certification information decrypted by said decrypting means, whether a sender of said electronic mail is an authorized user;

storing means for storing, if said sender of said electronic mail has been certified by said certifying means to be an authorized user, said control command extracted by said second extracting means; and

control means for controlling said [electric appliance] timer video recording reservation function of the physically separate video recording device to reserve an operation time of said physically separate video recording device based on said control command stored in said storing means[, wherein said electric appliance is physically remote from said control means, wherein said control means has a timer reservation function, and wherein said control means reserves an operation time of said electric appliance].

5. (Four Times Amended) A reception method for controlling [an electric appliance] a video recording device performed without using interior components of the video recording device , the reception method comprising the steps of:

receiving an electronic mail transmitted through a network;

a first extracting step of extracting encrypted certification information inserted in said electronic mail received in said receiving step;

a second extracting step of extracting a control command added to said electronic mail to control a reservation function of said video recording device so as to reserve an operation time of said video recording device [electric appliance];

decrypting said certification information extracted in said first extracting step;

certifying, by referencing the certification information decrypted in said decrypting step, whether a sender of said electronic mail is an authorized user;

storing, if said sender of said electronic mail has been certified in said certifying step to be an authorized user, said control command extracted in said second extracting step; and

controlling said [electric appliance] reservation function of said video recording device so as to reserve the operation time thereof based on said control command stored in said storing step[, wherein said electric appliance is controlled remotely from a physical

location of the second extracting step, and said step of controlling has a timer reservation function, and said step of controlling reserves an operation time of said electric appliance].

8. (Four Times Amended) A transmitting/reception system for controlling [an electric appliance] a video recording device physically separate therefrom, the transmitting/reception system comprising:

input means for generating at least a portion of an electronic mail;

encrypting means for encrypting predetermined information;

first addition means for adding, as certification information, the information encrypted by said encrypting means to said electronic mail [inputted] generated by said input means;

second addition means for adding a control command to said electronic mail [for controlling the electric appliance] to control a reservation function of the video recording device to reserve an operation time thereof;

transmission means for transmitting through a network said electronic mail with said certification information added by said first addition means and said control command added by said second addition means;

reception means for receiving said transmitted electronic mail;

first extraction means for extracting said certification information from said electronic mail received by said reception means;

second extraction means for extracting said control command from said electronic mail received by said extraction means;

decrypting means for decrypting said certification information extracted by said first extraction means;

certifying means for certifying, by referencing said certification information decrypted by said decrypting means, whether a sender of said electronic mail is an authorized user;

storing means for storing, if said sender of said electronic mail has been certified by said certifying means to be an authorized user, said control command extracted by said second extraction means; and

control means for controlling said [electric appliance] reservation function of the video recording device to reserve an operation time thereof based on said control command stored in said storing means[, wherein said electric appliance is physically remote from said control means, wherein said control means has a timer reservation function, and wherein said control means reserves an operation time of said electric appliance].

9. (Four Times Amended) A transmitting/reception method for controlling [an electric appliance] a video recording device performed without using interior components of the video recording device, the transmitting/reception method, comprising the steps of:

inputting information to generate at least a portion of an electronic mail;

encrypting predetermined information;

a first adding step of adding, as certification information, information encrypted in said encrypting step to said electronic mail [inputted] generated in said inputting step;

a second adding step of adding to said electronic mail a control command to control a reservation function of the video recording device to reserve an operation time thereof [for controlling the electric appliance];

transmitting through a network said electronic mail with said certification information added in said first adding step and said control command added in said second adding step;

receiving said transmitted electronic mail;

a first extracting step of extracting said certification information from said received electronic mail;

a second extracting step of extracting said control command from said received electronic mail;

decrypting said certification information extracted in said first extracting step;

certifying, by referencing said certification information decrypted in said decrypting step, whether a sender of said electronic mail is an authorized user; and

storing, if said sender of said electronic mail has been certified in said certifying step to be an authorized user, said control command extracted in said second extracting step; and

controlling said [electric appliance] reservation function of the video recording device to reserve an operation time thereof based on said control command stored in said storing step[, wherein said electric appliance is controlled remotely from a physical location of the second extracting step, and said step of controlling has a timer reservation function, and said step of controlling reserves an operation time of said electric appliance].--